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9/26/07 #19

In re Application of:  
Data, Paul Joseph, et al.  
Serial No. 09/872,976  
Filed: May 31, 2001  
Docket: 659/829  
Title: FULL WRAPPING DISPOSABLE  
REFASTENABLE AND  
ADJUSTABLE PANT

DECISION ON PETITION  
UNDER 37 CFR § 1.181

This is a decision on the petition filed on November 21, 2003 under 37 CFR § 1.181. Petitioner requests that certain comments and objections made by the examiner in the Advisory Action filed September 23, 2003 be withdrawn, stricken or otherwise corrected.

The petition is granted-in-part.

Background

The petition filed under 37 CFR § 1.181 requests a review of the examiner's challenges and objections to three different aspects of the application including, the claim of priority to the '951 application, amendments to Figure 2, and the identification of trademarks in the specification.

The first issue raised in the petition involves the claim of priority to the '951 application. In the original application filed May 31, 2001, the petitioner failed to identify the relationship between the present application and the '951 application. This issue was raised in the Office action mailed March 27, 2002. The petitioner then filed a Preliminary Amendment and Request for Corrected Filing Receipt on January 24, 2002, indicating that the present application was a continuation of the '951 application. Subsequently, in the Office action mailed July 1, 2003 the examiner noted "the disclosure of the invention in the parent application ('951) does not appear to be the same as the disclosure of the invention in the instant application." In the Advisory Action mailed September 23, 2003, the examiner stated "the applicants could change the claim of priority to one in which this application is a CIP of the '951 application or applicant could point out where there is support in the '951 application." The petitioner claims to be entitled to the benefit of priority to the '951 application based on the incorporation by reference of the '951 application into the present application.

The second issue presented in the petition concerns amendments to Figure 2. In the office Action mailed March 27, 2002, the examiner objected to element 5 in Figure 1B and Figure 2, finding them to be inconsistent. The petitioner then amended element 5 in Figure 2, changing its designation from element 5 to element 51 (designation 51 not having been used in any other figure). In the response dated September 20, 2002, the petitioner claimed that element 5 was distinct from element 51, whereby element 51 requires only the outer member of the pant to create the fastening panel (as describe on page 4, line 2), and element 5 requires a second patch of material to create the fastening panel. The examiner continued to object to Figure 2 in the Advisory Action dated September 23, 2003, arguing that that "Figure 2 would be much clearer if on page 4, line 2, after panel - see 51 in Figure 2 - could be inserted." The petitioner maintains that the examiner's comment has no legal or factual basis and requests that it be withdrawn from the record.

The final issue raised in the petition concerns the examiner's objections to the manner in which trademarks are identified in the application. In the Office action mailed March 27, 2002, the examiner noted that trademarks "should be capitalized wherever they appear and be accompanied by the generic terminology." In the response dated September 20, 2002, the petitioner amended the trademarks identification by using capitalization in conjunction with the proper trademark symbol. The examiner object to this representation in both the office Action file July 01, 2003 and the Advisory Action filed September 23, 2003, claiming that the use of capitalization *and* "®" together was improper. The petitioner maintains that such representation is appropriate and requests that the examiner's comments be withdrawn from the record.

#### Discussion and Decision

A review of the record indicates that the Preliminary Amendment filed on January 24, 2002 properly clarified the relationship between the present application and the '951 application as a continuation. Once the relationship was identified, the examiner objected to the classification of the present application as a continuation of the '951 application in the Office Action mailed July 1, 2003 and the Advisory Action mailed September 23, 2003. The examiner stated that the '951 application did not appear to be the same as the disclosure in the present application as "the '951 application did not appear to include the length of the side panel as claimed."

The background section of the '951 application, (line 13, page 1) states, "The present invention provides a new and useful stretchable composite that may have application in these as well as other areas. For example, this composite may also be suited for installation in disposable diapers, pants and adult incontinence articles as waistbands, stretch side panels, closure tapes, frontal tapes, back panels, leg bands, and the like." These garments described in the '951 application inherently have length. Therefore, the examiner's objection to the claim of priority is hereby withdrawn.

The second issue raised by the petitioner concerns the examiner's objection to Figure 2. In the Advisory Action mailed September 23, 2003, the examiner stated that "the invention shown in Figure 2 would be clearer if on page 4, line 2, after "panel" – see 51 in Figure 2 – could be inserted." The petitioner claims that the inclusion of such language is unnecessary based on the

description of element 51 of Figure 2 on page 4, line 2, which provides, "alternatively, an outer member may serve as the fastening panel." However, there is no indication from the language on page 4, line 2 that this description is a representation of element 51 in Figure 2, nor is there any other indication in the specification that element 51 actually represents the absence of a secondary patch of material to create a fastening panel. Essentially, there is no indication that page 4 line 2 describes element 51 in Figure 2. Therefore, the examiner's suggestion is reasonable and would in fact serve to clarify the specification.

The final issue, regarding proper identification of trademarks, is addressed in the M.P.E.P. With respect to trademarks, the M.P.E.P 608.01(v) states:

Trademarks should be identified by capitalizing each letter of the mark (in the case of word or lettermarks) or otherwise indicating the description of the mark (in the case of marks in the form of a symbol or device or other nontextual form). Every effort should be made to prevent their use in any manner which might adversely affect their validity as trademarks. Capitalize each letter of the word in the bracket or include a proper trademark symbol, such as <sup>TM</sup> or © following the word

This language indicates that trademarks may be identified by capitalization or the use of the proper trademark symbol. However, the M.P.E.P does not require that trademarks be identified only in the alternative. Instead, the M.P.E.P specifically states that every effort should be made to prevent the use of trademarks in any manner which might adversely affect their validity as marks. In light of this language, the use of capitalization or the use of the proper trademark symbol merely represents the minimum requirement for trademark identification and the petitioner's use of capitalization and the trademark symbol to identify trademarks is proper. Therefore, the examiner's objection to the trademark identification is hereby withdrawn.

#### Summary

The petitioners' request with respect to the examiner's objections to the claim of priority and to the trademark identification is granted and these objections are to be considered withdrawn. The petitioners' request for withdraw of the examiner's objections to Figure 2 is dismissed.

#### PETITION GRANTED-IN-PART.

Any inquiry regarding this decision should be directed to Allan N. Shoap, Special Programs Examiner, at (571) 272-4514.

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for Frederick R. Schmidt, Director  
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